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PCT/GL/ISPE/1
ORIGINAL: English
DATE: March 11, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PATENT COOPERATION TREATY (PCT)

PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

(Guidelines for the Processing by International Searching and
Preliminary Examining Authorities of International Applications
Under the Patent Cooperation Treaty)

as in force from March 25, 2004

1. This document contains the text, as in force from March 25, 2004, of the PCT International Search and Preliminary Examination Guidelines, established by the International Bureau of WIPO after consultation with the International Searching and Preliminary Examining Authorities under the PCT with a view, in particular, to implementing the amendments of the PCT Regulations which entered into force on January 1, 2004.
2. The Guidelines apply to the processing of international applications filed on or after January 1, 2004. They supersede the PCT International Search Guidelines, as in force from September 18, 1998 (document PCT/GL/IS/1), and the PCT International Preliminary Examination Guidelines, as in force from October 9, 1998 (document PCT/GL/IPE/1), which were published in Special Issues of the *PCT Gazette* Nos. S-06/1998 and S-07/1998, respectively. The text of the present Guidelines is the same (subject to minor editorial changes) as in the provisional version of this document (document PCT/GL/ISPE/1 Prov.2) which has been applicable, in practice, since January 1, 2004.
3. The text will also be published in Special Issue No. S-02/2004 (dated March 25, 2004) of the *PCT Gazette*.

no objection should be raised if the invention can only be defined in such terms and if the result is one which can be achieved without undue experimentation (see paragraph 5.46), for example, directly and positively verified by tests or procedures adequately specified in the description and involving nothing more than trial and error. For example, the invention may relate to an ashtray in which a smouldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may vary considerably in a manner difficult to define whilst still providing the desired effect. So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be achieved without being objected to for lack of clarity, provided that the description includes adequate directions to enable the reader to determine the required dimensions by routine test procedures.

5.36 Where the invention relates to a product, it may be defined in a claim in various ways, viz., by a chemical formula, as a product of a process or by its parameters. Definition of a product solely by its parameters may be appropriate in those cases where the invention cannot be adequately defined in any other way, provided that those parameters can be clearly and reliably determined either by indications in the description or by objective procedures which are recognized in the art. The same applies to a process related feature which is defined by parameters. This can arise, for example, in the case of macromolecular chains. Cases in which non-art recognized parameters are employed, or a non-accessible apparatus for measuring the parameter(s) is used, may be objectionable on grounds of lack of clarity. The examiner should be aware of the possibility that applicants may attempt to employ unusual parameters to disguise lack of novelty (see paragraph 12.04).

5.37 Where a claim for an apparatus or a product seeks to define the invention by reference to features of the use to which the apparatus or product is to be put, a lack of clarity can result. This is particularly the case where the claim not only defines the product itself but also specifies its relationship to a second product which is not part of the claimed invention (for example, a cylinder head for an engine, where the former is defined by features of where it is connected in the latter). Such a claim must either set forth a clear definition of the individual product being claimed by wording the claims appropriately (for example, by substituting "connectable" for "connected"), or be directed to a combination of the first and second products (for example, "engine with a cylinder head" or "engine comprising a cylinder head"). It may also be permissible to define the dimensions and/or shape of a first product in an independent claim by general reference to the dimensions and/or corresponding shape of a second product that is not part of the claimed first product but is related to it through use (for example, in the case of a mounting bracket for a vehicle number-plate, where the bracket frame and fixing elements are defined in relation to the outer shape of the number-plate).

5.38 Particular attention is required whenever the word "about" or similar terms, such as "approximately," are used. Such a word may be applied, for example, to a particular value (for example, "about 200°C") or to a range (for example, "about X to about Y"). In each case, the examiner should exercise judgment as to whether the meaning is sufficiently clear in the context of the application read as a whole. Moreover, if such words as "about" prevent the invention from being unambiguously distinguished from the prior art, an objection should be raised as to lack of novelty or inventive step.

Clarity of Other Terms

5.39 Trademarks and similar expressions characterize the commercial origin of goods, rather than the properties of the goods (which may change from time to time) relevant to the invention. Therefore the examiner should invite the applicant to remove trademarks and similar expressions in claims, unless their use is unavoidable; they may be allowed

Inherent or Implicit Disclosure

12.04 Lack of novelty may be apparent from what is explicitly stated in a published document, or it may be apparent from an inherent or implicit teaching of the document. For example, where the elastic properties of rubber are relied upon in a document that does not explicitly state that rubber is an “elastic material,” a claim to an “elastic material” is anticipated because the rubber taught in the prior art inherently is an “elastic material”. Alternatively, lack of novelty may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. Lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching. Otherwise it should be considered in respect of inventive step (see chapter 13).

Interpretation of Claims

12.05 In interpreting claims for the consideration of novelty, the examiner should have regard to the guidance given in paragraphs 5.20 to 5.41. In particular, the examiner should remember that statements in the claim reciting the purpose or intended use must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or in the case of process claims, a difference in the process steps) between the claimed invention and the prior art. Non-distinctive characteristics of a particular intended use should be disregarded (see paragraphs 5.21 to 5.23). For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (for example, the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated but implied by the particular use should be taken into account. For example, if a claim refers to a “mould for molten steel”, this implies certain limitations for the mould. Therefore a plastic ice cube tray with a melting point much lower than that of steel would not come within the claim which would thereby be considered as being novel.

Combining Documents

12.06 It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together (see paragraph 13.12). However, if a document (the “primary” document) refers explicitly to a second document (for example, as providing more detailed information on certain features), the teachings of the second document may be regarded as incorporated into the primary document to the extent indicated in the primary document. Equally, it is permissible to use a dictionary or similar document of reference in order to interpret how a special term used in the primary document would have been understood on the date of publication. It is also permissible to rely on additional documents as evidence to show that the disclosure of the primary document was sufficient (for example, for a chemical compound to be prepared and separated or, in the case of a product of nature, to be separated). See paragraph 12.02 and the appendix to this chapter. It is also permissible to rely on additional documents as evidence to show that a characteristic not disclosed in the primary document was inherent in the primary document on the date of publication of the primary document (for example, documents that teach rubber to be an “elastic material” for the example set forth in paragraph 12.04).

Alternatives

12.07 Where a claim contains alternatives, for example Markush claims (P1, P2, P3 ... Pn), any alternatives disclosed in the prior art are anticipated.